

REMARKS

Claims 1, 3-4, 7-8, 10-21, 23, 24, and 26 were pending. The applicant amends claims 1, 4, 12-14, and 23, adds new claim 28 and cancels claims 10, 11, 16-18, and 27. Claims 1, 3-4, 7-8, 12-15, 19-21, 23, 24, 26, and 28 are presented for examination.

The applicants request that the rejection of claim 4 was rejected under 35 U.S.C. § 112 be withdrawn in view of the amendment of claim 4.

Claims 1, 3-4, 7-8, 10-21, 23, 24, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,759,461 ("Jarvenkyla"), alone or in combination with U.S. Pat. No. 6,565,938 ("Toyosumi") or U.S. Pat. No. 6,127,662 ("Katz").

In order to expedite prosecution, the applicants amend claims 1 and 23 to include the features previously included in claims 10 and 11. Claim 1, as amended, is directed to a plastics pipe with an outer removable skin layer comprising an adhesion-reducing additive

**wherein the adhesion reducing additive is an ester of a polyhydric alcohol; and
wherein the adhesion-reducing additive in the skin layer is present in an amount of from
0.5% to 10% by weight.**

Claim 23, as amended, also includes these features. The cited prior art is silent about both of these features.

The examiner acknowledges that "Jarvenkyla is silent regarding the amount of adhesion reducing additive used and also the characteristics of the pipes."¹ The examiner suggested that it would be obvious to a skilled person to vary the amount of adhesion reducing additive in the skin layer as a matter of routine experimentation.² However, in any routine experimentation, there needs to be some guidance as to the relative starting point. If this is not the case, the starting point for the skilled person's experimentation may turn out to be quite distant from the actual effective range that ultimately can be used. This means that the reasonable experimentation may not work and thus fail to find the correct parameters. Thus, in the absence of any guide as to the quantities that might represent a reasonable and proper starting point for experimentation, it is unreasonable to suggest that the relative amounts of adhesion reducing additive could be

¹ Office action dated January 22, 2009, page 4.

² Office action dated January 22, 2009, page 4.

discovered by routine experimentation. In this regard, the applicants point out that the magnitude of possible ranges that would need to be investigated would vary enormously and in principle could be positioned at a variety of concentrations. Equally, the actual ranges of any workable concentration of the adhesion reducing additive could vary significantly and extend over a number of possible log ranges, i.e. over several orders of magnitude. It is difficult to see how, in the absence of guidance, the skilled person could end up at a particular claimed range. Thus, this rejection lacks the rational underpinning necessary to support the legal conclusion of obviousness.³

The examiner also acknowledges that “Jarvenkyla is silent with regard to the different types of adhesion reducing additives” but asserts that the subject matter of previously pending claim 11 is obvious relative to the combination of Jarvenkyla and Toyosumi.⁴ However, the proposed combination of references is inappropriate.

The Examiner cites KSR for the proposition that where work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another field.⁵ However, KSR specifies that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”⁶ The necessary rational underpinning is lacking here. Jarvenkyla relates to the formation of a two layer plastics pipe which is to be laid in the ground. Toyosumi is directed towards a resin composition used to make shaped articles having characteristics such as gas barrier properties and low temperature heat drawability. These are entirely different technical fields and certainly are not adjacent fields of endeavor. The articles which are the subject of Toyosumi include packaging materials and are generally in the form of sheet materials. Thus, these articles are intended as packaging. Jarvenkyla and Toyosumi are clearly in entirely different fields. Indeed, this can be seen from, for example, the international classifications in which the two documents are placed. Jarvenkyla is in an entirely different classification from Toyosumi.

³ KSR International Co. v. Teleflex Inc. et al., 127 S.Ct. 1727, 1741.

⁴ Office action dated January 22, 2009, page 5.

⁵ Office action dated January 22, 2009, page 7.

⁶ KSR International Co. v. Teleflex Inc. et al., 127 S.Ct. 1727, 1741.

While a feature available in one design field can, in principle, be transported to another field, this is only the case where one might see a benefit in doing so. In other words, there has to be a motivation to do so. In the present case, the applicants submit that the two fields are so different that the skilled person in the field of pipe production would not even be aware of the teaching of Toyosumi much less consider modifying the methods and processes described by Jarvenkyla with the teachings of Toyosumi. Certainly, there is no commercial or other motivation for such modifications.

Moreover, using such a feature to improve a similar article in the same way would not be obvious if its actual application is beyond the person's skill.⁷ In the present case, the applicants submit that the transportation of the cited features from Toyosumi to Jarvenkyla would be beyond the person's skill. A person skilled in the art of pipe manufacture would not be aware of the intricacies of manufacturing lightweight laminate plastics films for packaging and consequently would not have the skill to take any useful features from that field of technology. Consequently, the combination of these two documents is not a combination that would be adopted in practice. Rather, the proposed combination appears to be purely based on impermissible hindsight.⁸

The applicants also pointed out that even the invalid combination of Jarvenkyla and Toyosumi, does not provide all of the features of claims 1 and 23, as amended. Neither Jarvenkyla nor Toyosumi has been shown to describe using an adhesion-reducing additive in the form of an ester of a polyhydric alcohol in a skin layer wherein the adhesion-reducing additive in the skin layer is present in an amount of from 0.5% to 10% by weight. Thus, the combined teaching of Jarvenkyla and Toyosumi does not provide a two-layer plastics pipe which also has the adhesion-reducing additive in the form of an ester of a polyhydric alcohol wherein the adhesion-reducing additive in the skin layer is present in an amount of from 0.5% to 10% by weight. Consequently, Jarvenkyla and Toyosumi, alone or in combination, do not provide the basis of a prima facie case of obviousness of the pending claims.

Katz has not been shown to remedy the deficiencies of Jarvenkyla and Toyosumi.

⁷ KSR International Co. v. Teleflex Inc. et al., 127 S.Ct. at 1740.

⁸ KSR International Co. v. Teleflex Inc. et al., 127 S.Ct. at 1742.

Claim 26 is directed towards a method of making a joint to a plastics pipe according to claim 1. Thus, claim 26 is patentable over the cited art for at least the same reasons as claim 1.

For at least these reasons, the applicants request the withdrawal of the rejections of the pending claims as obvious over Jarvenkyla, alone or in combination with Toyosumi or Katz.

All of the dependent claims are patentable for at least similar reasons as those for the claims on which they depend are patentable.


Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

The fees for the Request for Continued Examination and the Petition for Two-Month Extension of Time in the total amount of \$1170 are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply all charges or credits to Deposit Account No. 06 1050, referencing Attorney Docket No. 09294-0020US1.

Respectfully submitted,

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